

**REMARKS**

This Amendment responds to the Official Action filed on December 1, 2004. A petition for a one-month extension of the term for response to said Official Action, to and including April 1, 2005, is transmitted herewith. Claims 1-60 are pending in the application.

**I. Objections to the Supplemental Oath**

The Applicants' attorney Robert Cohen, Esq. spoke with the Examiner on January 7, 2005, regarding filing a Supplemental Oath. After reviewing the file, the Examiner acknowledged that the declaration had been filed. Accordingly, Applicant's respectfully contend that the Examiner's objection is overcome.

**II. Objections to the Specification**

The Examiner has objected to the abstract of the disclosure because it contains the statement "309467\_1.doc." Applicants have deleted this statement from the abstract and respectfully submit that the objection to the abstract is overcome.

The Examiner has objected to the Title of the Invention. In accordance with the Examiner's suggestion, Applicant has amended the title to recite "A System and Method Of Content Copy Control." Applicants respectfully submit that the Examiner's objection to the title is overcome.

**III. 35 U.S.C. § 112 Rejections**

The Examiner has rejected claims 1, 7, 13 and 19 for failing to provide antecedent basis for the limitation "attribute information." Although Applicants assert that antecedent basis was provided for each of the rejected claims, Applicants have deleted this limitation from those claims, and

have provided new dependent claims 42, 44, 46 and 48 that contain this limitation. Applicants respectfully submit that the Examiner's 35 U.S.C. § 112 rejections are overcome, and that the claims are in condition for allowance.

**IV. Amendments To Claims 1, 7, 13, 19, 34, 38, 39 and 40**

Claims 13, 40, and 41 were amended to include either a database or external server for storing copy information regarding whether copying is permissible for each of the contents. Claims 1, 13, and 38 were amended to include the limitation of a collation unit (or searching step) that searches the database of copy information and that produces the results of the search. Applicants contend that there is support in the specification for these amendments and that no new matter has been added. See Application, Paragraphs 65-76. Applicants further contend that, as will be described in further detail below, these features are not taught or disclosed by the prior art. Accordingly, these features serve to more clearly distinguish Applicants' invention over the prior art.

**V. 35 U.S.C. §102 (e) Rejections**

The Examiner has rejected claims 1-37 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,707,774 ("Kuroda"). The Examiner contends that Kuroda discloses a database for determining whether copying is permissible for the contents. As will be explained in further detail herein, Applicants respectfully assert that the Examiner's rejection is misplaced.

All of the independent claims contain one or more limitations that are not taught or suggested by Kuroda. Specifically, each of the independent claims recites either or both of "a database for storing copy information," and a

"collation unit" (or a searching step) for searching the database of copy information based on identification information. The claimed invention allows/prevents copying of a particular item by first reading or obtaining identification information about the contents of a particular item, collating the information against the information previously stored in a database of copy information, compiling and recording the results of the search in the database, and, based on the results, allowing/preventing copying of information.

In contrast to the Applicants' claimed invention, Kuroda fails to teach a "database for storing copy information regarding whether copying is permissible," nor a "collation unit" or searching function for searching the database of copy information, and producing the results of the search. Rather, Kuroda teaches a reproducing system that reads information embedded in digital video or analog video information regarding copying a satellite broadcast or the like, and then permits or prevents copying based on the embedded information without comparison to a database of copy information. (Col. 7, lns. 38-54.) To determine whether copying is permissible, the information obtained from the broadcast is compared to a Control Management Table ("CGMT"). (See Col. 10, lns. 13-20.) The CGMT contains commands that correspond to whether the information indicates, for example, Copy Free, One Copy, or Never Copy. If the information indicates, "never copy", and an external apparatus is an authorized recording apparatus, the corresponding command on the CGMT table is to prevent recording of the broadcast. The CGMT is therefore nothing more than a pre-prepared table of commands that corresponds to information obtained from a satellite broadcast. In this regard, the Kuroda CGMT is not a searchable database of copy information, such as disclosed by Applicants' invention. The CGMT does not compile a database

of information regarding the permissibility of copying and/or attributes about each individual broadcast. Moreover, the system does not contain a collation unit or the like that searches the CGMT to determine whether the information from the broadcast has been previously recorded so as to permit or deny recording based on the information stored in the database. Indeed, in order to accomplish the invention of Kuroda, there is no need to determine whether the newly obtained information has been previously recorded in the database. Consequently, because copying to an external device does not depend on whether a broadcast has been previously recorded, Kuroda does not teach or suggest a "database operable to store copy information regarding whether copying is permissible" or "a collation unit" or searching step for searching said database based on identification information. Thus, Kuroda cannot be relied upon by the Examiner to support his § 102 (e) rejections.

#### **VI. 35 U.S.C. § 103 Rejections**

The Examiner has rejected claims 38-41 under 35 U.S.C. § 103(a) as being unpatentable over Kuroda, in view of U.S. Patent No. 6,687,411 ("Miura"). For the same reasons set forth above, Applicants contend that the Examiner cannot rely upon Kuroda to form the basis of an obviousness rejection. Regarding claims 38-41, Kuroda fails to teach or suggest a database storing information regarding whether copying is permissible for each of the contents. Additionally, Kuroda fails to teach or suggest collating identification information to determine whether a matching record exists in the database. As such, the combination of Kuroda and Miura does not achieve Applicants' claimed invention. Accordingly, Applicants contend that Kuroda, in combination with Miura, cannot render Applicants' invention obvious.

**VII. New Claims 42-60**

Applicants have also added new claims 42-60. Claims 42, 44, 46, 48, 51, 53 and 55 recite that the database can be searched based on attribute information. Claims 43, 45, 47, 49, 52, 54, and 56-60 recite that copy information includes an electronic watermark corresponding to each of the contents. Finally, claim 50 recites that the searching means is a collation unit. Applicants respectfully contend that for the same reasons set forth above, these claims are in condition for allowance. Furthermore, Applicants assert that no new matter has been added and that there is support in the specification for these newly added claims. See Application, Paragraphs 65-76

**VIII. Conclusion**

In view of the above, it is respectfully requested that these amendments now be entered, and that prosecution on the merits of this application now be initiated. If, however, for any reason the Examiner does not believe such action can be taken, it is respectfully requested that the Examiner telephone Applicants' attorney at (908) 654-5000 in order to overcome any objections which the Examiner may have. If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Applicants' Deposit Account No. 12-1095 therefor.

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Respectfully submitted,

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